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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,127	07/23/2001	Roy J. Mankovitz	GS/073 CONT.	2809

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EXAMINER

YIMAM, HARUN M

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,127

Applicant(s)

MANKOVITZ ET AL.

Examiner

Harun M. Yimam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/14/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/23/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Limitation "compiling a list of one or more guides from the stored guide identifiers" in claim 1, on line 17, is vague and indefinite because it is unclear as to which of the stored "guide identifiers" are being referred to. It could refer to the guide identifiers comprised in the first guide identifier, the guide identifiers comprised in the second guide identifier, or all of the guide identifiers in both the first and the second guide identifiers.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,341,195 with additional limitations: "compiling a list of one or more guides from the stored guide identifiers; displaying the list of the guides for viewer selection; selecting a guide for future reception; and storing the guide identifier for the selected guide". Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons provided below.

5. Claim 1 of the instant application corresponds to patented claims 1, 9, 10 and 13 of U.S. Patent No. 6,341,195 with additional limitations. Although the conflicting claims are not identical, both claims are drawn to the same invention: "A method for acquiring data related to television programming". These claims differ in scope due to the fact that patented claims 1, 9, 10 and 13 are broader in scope than the instant application's claim 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify patented claims 1, 9, 10 and 13 by

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narrowing their scope with the additional limitations for the benefit of providing multiple television guides for user selection.

Allowance of claim 1 would result in the unwanted time-wise extension of the monopoly granted for the invention as defined in patented claims 1, 9, 10 and 13.

Claim 2 of the instant application corresponds to patented claim 2.

Claim 3 of the instant application corresponds to patented claim 8.

Claim 4 of the instant application corresponds to patented claims 1, 9, 10 and 13.

6. Claim 5 of the instant application corresponds to patented claims 1, 9, 10 and 13 of U.S. Patent No. 6,341,195 with additional limitations: "displaying the first and second guide identifiers on a display; receiving a viewer selection of one of the displayed guide identifiers; and storing reception information for the selected guide identifier, the reception information allowing future reception of an associated television program schedule guide". Although the conflicting claims are not identical, both claims are drawn to the same invention: "A method for acquiring data related to television programming". These claims differ in scope

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due to the fact that patented claims 1, 9, 10 and 13 are broader in scope than claim 5 of the instant application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify patented claims 1, 9, 10 and 13 by narrowing their scope with the additional limitations for the benefit of providing a viewer preferred television guide for user selection.

Allowance of claim 5 would result in the unwanted time-wise extension of the monopoly granted for the invention as defined in patented claims 1, 9, 10 and 13.

Claim 6 of the instant application corresponds to patented claim 8.

7. Claim 7 of the instant application corresponds to patented claims 1, 9, 10 and 13 of U.S. Patent No. 6,341,195 with additional limitations: "displaying the first and second guide identifiers on a display; receiving a viewer selection of one of the displayed guide identifiers; and storing reception information for the selected guide identifier, the reception information allowing future reception of an associated television program schedule guide". Although the conflicting claims are not identical, both claims are drawn to the same invention: "A method for acquiring data related to television programming". These claims differ in scope

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due to the fact that patented claims 1, 9, 10 and 13 are broader in scope than claim 7 of the instant application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify patented claims 1, 9, 10 and 13 by narrowing their scope with the additional limitations for the benefit of providing a viewer preferred television guide for user selection.

Allowance of claim 7 would result in the unwanted time-wise extension of the monopoly granted for the invention as defined in patented claims 1, 9, 10 and 13.

Claim 8 of the instant application corresponds to patented claim 8.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Klosterman (US 5,684,525).

Considering claim 1, Klosterman discloses a method for acquiring data related to television programming comprising the steps of: receiving from a first television signal source (local cable) a television signal capable of incorporating embedded data relating to television programming (figure 1a and column 4, lines 43-63); determining if data related to television programming is embedded in the television signal from the first source (television program data is embedded in the transmitted signal—column 4, lines 43-63); if data related to television programming is embedded in the television signal from the first source, storing at least a portion of the embedded data in an electronic memory (RAM 42—column 4, lines 49-53), the stored portion including a first guide identifier (column 3, lines 1-4); receiving from a second signal source (DBS) a television signal capable of incorporating embedded data relating to television programming (figure 1a and column 4, lines 43-63); determining if data related to television programming is embedded in the television signal from the second source (television program data is embedded in the transmitted signal—column 4, lines 43-63); if data related to television programming is embedded in the television signal from the second source, storing at least a portion of the embedded data in the electronic memory (RAM 42—column 4, lines 49-53), the stored portion including a second guide identifier (column 3, lines 1-4); compiling a list of one or more guides from the stored guide identifiers (column 5, line 59 – column 6, line 17); displaying the list of the guides for viewer selection (channels



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are displayed in a guide in an order associated with their particular source, which implies that a separate guide is displayed for a particular source—column 6, lines 17-21 and 31-37); selecting a guide for future reception (since a separate guide is displayed for a particular source—column 6, lines 31-37 and as explained above, the user can specify his/her preference for a source by selecting a particular guide: source (i.e. cable or DBS), for future reception—column 6, lines 39-60); and storing the guide identifier for the selected guide (the user's selection is saved in the RAM 42 of the coordinator 20, which is capable of automatically lining up channels based on user's habits—column 6, lines 39-54).

As for claim 2, Klosterman discloses receiving from a third television signal source (secondary satellite 30 in figure 1a—column 3, line 55 – column 4, line 14) a television signal capable of incorporating embedded data relating to television programming (figure 1a and column 4, lines 43-63 and column 8); determining if data to television programming is embedded in the television signal from the third source (television program data is embedded in the transmitted signal—column 4, lines 43-63); and if data related to television programming is embedded in the television signal from the second source, storing at least a portion of the embedded data in the electronic memory (RAM 42—column 4, lines 49-53), the stored portion including a third guide identifier (column 3, lines 1-4).

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With regards to claim 3, Klosterman discloses that the stored portion of embedded data comprises a sample guide (short description of a show displayed as an additional information within the guide—column 7, lines 25-32).

Regarding claim 4, Klosterman discloses that the stored portion of embedded data comprises a guide identifier (column 3, lines 1-4) and data relating to guide information reception and the method further comprises storing the reception data for the selected guide (the user's selection is saved in the RAM 42 of the coordinator 20, which is capable of automatically lining up channels based on user's habits—column 6, lines 39-54).

Considering claim 5, Klosterman discloses a method for acquiring data related to television programming comprising the steps of: receiving from a first television signal source (local cable) data related to a first television program schedule guide (figure 1a and column 4, lines 43-63); storing at least a portion of the data related to the first television program schedule guide in memory, the stored portion including a first guide identifier (column 3, lines 1-4); receiving from a second television signal source (DBS) data related to a second television program schedule guide (figure 1a and column 4, lines 43-63); storing at least a portion of the data related to the second television program schedule guide in memory (RAM 42—column 4, lines 49-53), the stored portion including a second guide identifier (column 3, lines 1-4); displaying the first and second guide identifiers on a display (each channel displayed in a program guide has an

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identifier. Therefore, the displayed channels in program guide meet this limitation—column 6, lines 31-37 and column 7, lines 1-16); receiving a viewer selection of one of the displayed guide identifiers (the identifiers are located on each channel. When a user selects a certain program, the identifiers are indirectly selected—column 8, lines 39-67); and storing reception information for the selected guide identifier, the reception information allowing future reception of an associated television program schedule guide (the user's selection for the particular guide identifier is saved in the RAM 42 of the coordinator 20, which is capable of automatically lining up channels for future reception based on user's habits—column 6, lines 39-54).

As for claim 7, Klosterman discloses a television apparatus receiving television signals from a plurality of television signal sources comprising: a first input receiving from a first television signal source (local cable) data related to a first television program schedule guide (figure 1a and column 4, lines 43-63); a second input receiving from second television signal source (DBS) data related to a second television program schedule guide (figure 1a and column 4, lines 43-63); a memory (RAM 42—column 4, lines 49-53); a display (34 in figure 1d); and a processor coupled to the memory and display (36 in figure 1a), the processor including logic for: storing at least a portion of the data related to the first television program schedule guide in the memory (RAM 42—column 4, lines 49-53), the stored portion including a first guide identifier (column 3, lines 1-4); storing at least a portion of the data related to the second television program

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schedule guide in the memory(RAM 42—column 4, lines 49-53), the stored portion including a second guide identifier (column 3, lines 1-4); displaying the first and second guide identifiers on a display (each channel displayed in a program guide has an identifier. Therefore, the displayed channels in program guide meet this limitation—column 6, lines 31-37 and column 7, lines 1-16); receiving a viewer selection of one of the displayed guide identifiers (the identifiers are located on each channel. When a user selects a certain program, the identifiers are indirectly selected—column 8, lines 39-67); and storing reception information for the selected guide identifier, the reception information allowing future reception of an associated television program schedule guide (the user's selection for the particular guide identifier is saved in the RAM 42 of the coordinator 20, which is capable of automatically lining up channels for future reception based on user's habits—column 6, lines 39-54).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman (US 5,684,525) in view of Lawler (US 5,585,838).

Considering claims 6 and 8, Klosterman discloses that the stored portion of the embedded data comprises a sample guide (short description of a show displayed as an additional information within the guide—column 7, lines 25-32).

Klosterman fails to disclose that the stored portion of the embedded data related to the first and second television program schedule guides includes a sample of the first and second television program schedule guides.

In analogous art, Lawler discloses that the stored portion of the embedded data (program schedule information is stored in server 34 of figure 1) related to the first and second television program schedule guides (multiple program guides are disclosed—column 12, lines 30-42) includes a sample of the first and second television program schedule guides (the stored program schedule information includes a brief description or preview of the program—column 6, lines 3-15, column 10, lines 42-55 and figures 3 and 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Klosterman's system to include a sample guide of program schedule guides, as taught by Lawler, for the benefit of providing a brief description of the selected program in a particular program guide (column 6, lines 10-15).

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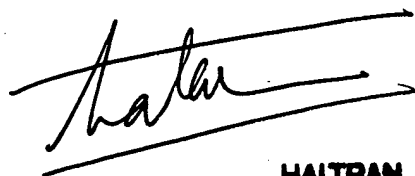
**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HMY

A handwritten signature in black ink, appearing to read 'HAITRAN', is written over two horizontal lines.

**HAITRAN  
PRIMARY EXAMINER**